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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,335	01/11/2002	Yair Frankel	P 282618	7410

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EXAMINER

KAZIMI, HANI M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/042,335

Applicant(s)

FRANKEL ET AL.

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/22/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application has been reviewed. Original claims 1-3 are pending. The objections and rejections cited are as stated below:

#### ***Specification***

2. The abstract of the disclosure is objected to because it exceeds the limit of 150 words in length. Correction is required. See MPEP § 608.01(b).
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 2 recites in the preamble "a method for providing a warranty relating to a transaction ---", the body of the claim does not indicate any limitation or step for providing a warranty relating to a transaction. The claim does transmit a response to the request for a warranty. However, this response could be a negative response to the request, which means that a warranty has not been created. For further examination, Examiner assumes that the response to the request for a warranty is the issuance of a warranty. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. § 101 reads as follows:  
"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
7. Claim 2 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Applicant's claim mentioned above is intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claim begins by discussing a system (ex. preamble of claim 2). However, the body of the claim discusses the specifics of a method (the steps) executed by the system. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Asay et al. US patent No. 5,903,882.

On page 3 of the specification, Applicant defines the word "warranty" to be a warranty which allows a third party to vouch for a user on a per-transaction basis, which

allows a third party to provide reliable and up-to-date warranties required between entities in many typical transactions.

Asay reference uses the word "assurance" in stead of "warranty", and based on the specification of the present application, and the definition of the word "assurance" of the Asay reference (col. 5, lines 1-28), it is clear that both terms are the same, because the issuance of a warranty in the present application and a certificate of assurance in Asay perform the same functionality by providing a more secure transaction in an electronic transaction system.

Based on the definitions above, the examiner considers the "secondary certificate of assurance" of Asay to be the same as "warranty" in claims 1, and 2.

Claims 1, and 2, Asay teaches a method and system for providing a warranty (certificate of assurance) relating to a transaction between two parties (column 5, lines 1-28), each party having a data communications device, in a system comprising an infrastructure composed of a plurality of locations each associated with a respective institution which provides services to clients, each location having a computer system, a database coupled to the computer system and storing information about each client of the institution and a data communications device coupled to the computer system for communication with the data communications device of any one party, each party being a client of at least one of the institutions (fig. 3, and column 10, lines 23-67), said method comprising:

transmitting a request for a warranty (certificate of assurance) from one party to the transaction which is a client of the respective institution to a respective location associated with the respective institution, which request includes information identifying the other party to the transaction and information about the nature of the transaction (fig. 3, column 5, lines 14-28, and column 10, lines 37-51);

conducting an exchange of information between the respective location and a location associated with a institution of which the other party is a client (fig. 3, and column 5, lines 1-28); and

transmitting a response to the request from the respective location to the one party (column 5, lines 19-28).

Claim 3, Asay teaches a method for aiding a plurality of different transactions carried out electronically between a plurality of parties (column 5, lines 1-28, column 12, lines 17-28, column 23, lines 32-47, and column 33, lines 36-56), said method comprising the steps of:

(a) providing an infrastructure which includes a plurality of institutions and communications systems interconnecting the institutions (fig. 3, and column 10, lines 23-67, column 12, lines 17-28, column 23, lines 32-47, and column 33, lines 36-56);

(b) designating a specific transaction and associating with the specific transaction two of the plurality of parties and the role of each of the two parties in the specific transaction, the two parties being party A and party B, respectively (fig. 3, column 5, lines 14-28, column 10, lines 37-51, and column 33, lines 36-56);

(c) determining a means for identification of each of the two parties (fig. 3, column 5, lines 14-28, and column 10, lines 37-51);

(d) assigning requirements that must be met by party A to carry out the specific transaction (column 10, line 37 thru column 12, line 28);

(e) requesting from party B to the infrastructure a warranty (certificate of assurance) that the requirements assigned in step (c) are met by party A (figs. 3, and 5, column 5, lines 1-28, column 10, line 37 thru column 12, line 28, and column 18, line 16 thru column 22, line 3);

(f) providing from the infrastructure to party B a response regarding the status of the warranty (certificate of assurance) requested in step (d) (column 5, lines 19-28, column 10, line 37 thru column 12, line 28, and column 21, line 55 thru column 22, line 3);

(g) completing the specific transaction according to the status of the warranty (certificate of assurance) resulting in a transaction complete state (column 21, line 55 thru column 25, line 29);

(h) having the infrastructure manage information about each of the parties, including information about outstanding warranties (certificates of assurance) for each of the parties and transactional administrative information (column 30, line 9 thru column 33, line 56).

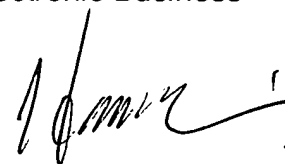


***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



**HANI M. KAZIMI  
PRIMARY EXAMINER**

Art Unit 3624

August 22, 2005